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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,749	07/21/2003	Odd N. Oddsen JR.	INNOFF 3.0-024	6349
530	7590	11/24/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			CHAN, KO HUNG	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,749

Applicant(s)

ODDSEN ET AL.

Examiner

Korie H. Chan

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10, 11, 19, 20, and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 18, 21, 22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Claims 5, 10, 11, 19, 20, and 23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected specie, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/13/2004.

***Response to Amendment***

The reply filed on 9/13/2004 is objected because it fails to include an accurate record of the listing of the claims. Claims 5, 10, 11, 19, 20, and 23 is listed as (original) when it should have been labeled (withdrawn). Applicant is reminded to label the claims accurately in future responses.

**DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Objections***

Claim 18 is objected to because of the following informalities: claim 18, line 1, after "comprising", "A" should not be capitalized. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-4, 6-9, 18, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation that the "inserts having

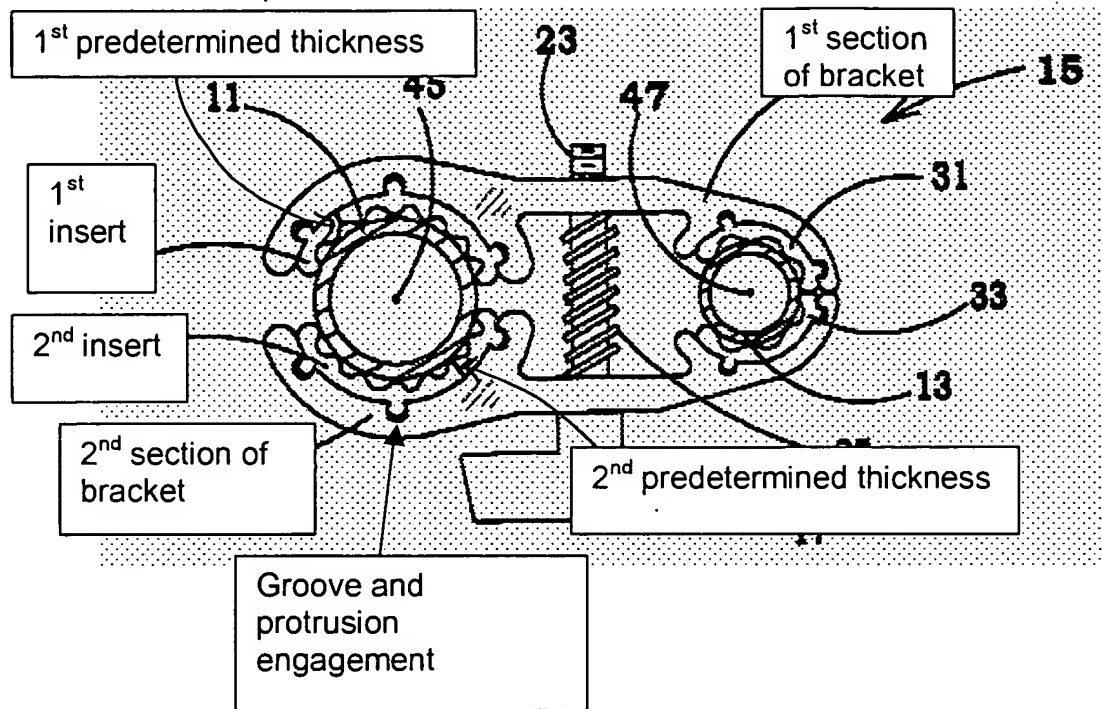
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same outside diameter and different inside diameter whereby the thickness of said inserts are different is vague and indefinite. By definition "a diameter is a line through the center of a figure or body" (Merriam-Webster's Collegiate Dictionary, tenth edition). However, it is unclear in applicant's recitation as to where the center of the insert is located and from what point to what point does a diameter start or end with such diameter going through a center of the insert. Further, it is also unclear what constitutes outside diameter and inside diameter. Similar recitation and vagueness are found in claims 8 and 18. Regarding claim 3, line 3, "a predetermined thickness therebetween" is vague and indefinite as it is not clear whether it is the same "thickness" recited in amended claim 1, line 8. Regarding claim 30, line 2, "an outer convex surface" should be "said outer convex surface".

***Claim Rejections - 35 USC § 102***

Claims 1-3, 7, 8, 18, 21, 22, 24-30, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Colley (US patent no. 5,769,556). Colley discloses all the claimed features of applicant's invention (see illustration below) wherein a first predetermined thickness (the thinness part of the insert or the thickness from the trough of the inner surface to the outer surface) defined between the inner and outer surface of one insert is different a second predetermined thickness (the thickness from the crest of the inner surface to the outer surface of the insert) of another insert (see illustration below) and wherein the insert is made of pliable material (Col. 3, lines 25-27).

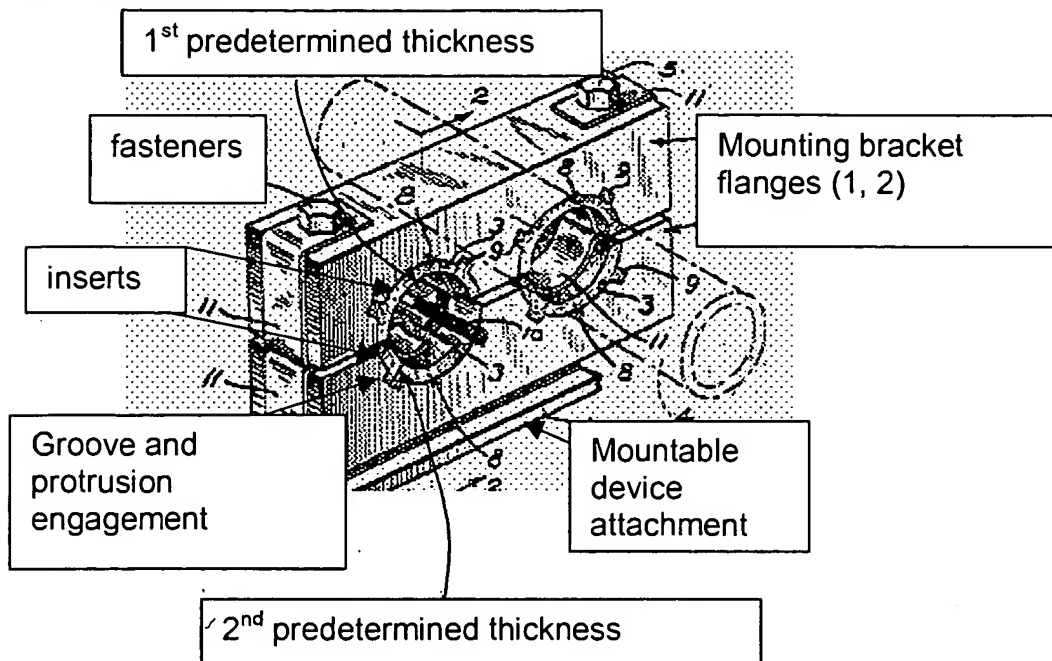
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Claims 1-4, 6-9, 18, 21, 22, and 24-30 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Morehouse (US patent no. 2,355,742).

Morehouse discloses all the claimed features of applicant's invention (see illustration below) wherein a first predetermined thickness (the thinness part of the insert) defined between the inner and outer surface of one insert is different a second predetermined thickness (the thickness from the inner surface to the outer surface of one of the protrusions of the insert) of another insert

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### ***Response to Arguments***

Applicant's arguments filed 9/13/2004 have been fully considered but they are not persuasive. Applicant's argument that the inserts of Colley and Morehouse are not interchangeable is irrelevant since such language is not found in any of the claims. Applicant's argument that the thickness of Colley and Morehouse are the same. Applicant claim language requires that a thickness of the inserts be different. As explained above, the inserts of Colley and Morehouse have at least two predetermined thicknesses which are different from each other. Consequently, Colley and Morehouse meets the limitations of the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

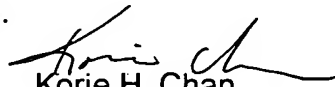
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 703-305-8079. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
November 22, 2004